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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

047092.00096

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Name _____

Application Number:

10/501,944

Filed: July 21, 2004

First Named Inventor:

Mikka POIKSELKA

Art Unit: 2456

Examiner: Brad McAdams

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

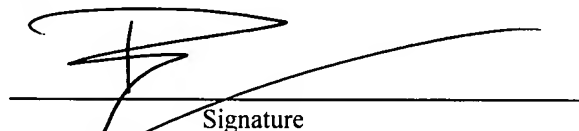
I am the

- ☐ Applicant/Inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed (Form PTO/SB/96)

☒ Attorney or agent of record.
Registration No. 52,738

☐ Attorney or agent acting under 37 CFR 1.34.

Registration Number if acting under 37 CFR 1.34 June 29, 2009
Date


SignatureBrad Y. Chin

Typed or printed name

703.720.7823

Telephone number

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:
Mikka POIKSELKA, *et al.*
Application No.: 10/501,944
Filed: July 21, 2004

Confirmation No.: 8466
Art Unit: 2456
Examiner: Brad McAdams
Attorney Dkt. No.: 047092.00096

For: METHOD AND SYSTEM FOR CHANGING A SUBSCRIPTION

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

June 29, 2009

Sir:

Applicants hereby submit this Pre-Appeal Brief Request for Review ("PABRR") of the final rejections of claims 1-20 and 32-43 in the above identified application. Claims 1-20 and 32-43 were finally rejected in the Final Office Action dated January 29, 2009 ("Office Action"). Applicants filed a Response to the Office Action on April 22, 2009 ("Applicants' Response"). In Applicants' Response, Applicants amended claim 2 and added new claim 44. The Office issued an Advisory Action dated May 19, 2009 ("Advisory Action"), indicating that Applicants' amendments to claims 2 and 44 would not be entered because they present additional claims without cancelling a corresponding number of finally rejected claims. Applicants hereby appeal the rejections of claims 1-20 and 32-43 and submit this PABRR. A Notice of Appeal is timely filed concurrently herewith.

Applicants respectfully submit that the cited references fail to disclose or suggest every feature recited in claims 1-20 and 32-43, rendering the rejections clearly erroneous. Applicants respectfully request reconsideration of the arguments submitted in Applicants' Response, and included herewith, and submit that claims 1-20 and 32-43 are in condition for allowance.

The Office Action rejected claims 1-20, 32-37, and 40-42 under 35 U.S.C. §102(e) as allegedly anticipated by Denenberg (U.S. Patent No. 6,859,649). The Office Action rejected claims 38-39 and 43 under 35 U.S.C. §103(a) as being allegedly unpatentable over Denenberg in view of Hurtt (U.S. Publication No. 2005/0117591). In Applicants' Response, Applicants presented arguments demonstrating that Hurtt was an invalid prior art reference under 35 U.S.C.

§103(c). The Office improperly issued an Advisory Action without addressing Applicants' arguments relating to Hurtta. Because the Office Action's rejections of claims 38-39 and 43 can not stand without Hurtta, Applicants submit that it was not proper to issue the Advisory Action. The Office should have issued a new Non-Final Office Action presenting new art references to reject at least claims 38-39 and 43. Applicants respectfully submit that the aforementioned claim rejections are in clear error; and therefore, respectfully request withdrawal of the claim rejections for at least the reasons discussed below.

Clear Error: “detecting a change in subscription information of a subscriber; checking whether a capability of a network element serving a terminal device of said subscriber is still in accordance with said changed subscription information; and initiating in response to the result of said checking a registration procedure for registering said terminal device of said subscriber to a new serving network element,” is not disclosed in Denenberg.

Applicants respectfully submit that the claims recite subject matter that is neither disclosed nor suggested in Denenberg. In particular, Denenberg fails to disclose or suggest, at least, “detecting a change in subscription information of a subscriber; checking whether a capability of a network element serving a terminal device of said subscriber is still in accordance with said changed subscription information; and initiating in response to the result of said checking a registration procedure for registering said terminal device of said subscriber to a new serving network element,” as recited in claim 1 (emphasis added).

The Office Action cited a **mobile device** (e.g., mobile communication device 125), as described in column 5, lines 3-6, column 4, lines 35-42, and column 7, line 46, to column 8, line 24 of Denenberg, to allege that Denenberg describes the “**network element**” recited in the pending claims. However, a review of these passages in Denenberg demonstrates that the Office Action failed to demonstrate that Denenberg describes each and every element recited in claim 1.

At column 5, lines 3-6, Denenberg describes “a terminal device of a subscriber,” e.g., the mobile communication device 125, rather than “a network element.” Furthermore, Figures 5 and 6, and the description of Denenberg at column 4, lines 35-42, and column 7, line 46, to column 8 line 24, each describe “a terminal device of the subscriber.” For example, Step 505 of Figure 5 describes a *mobile device*, and Step 525 of Figure 5 refers to whether a *mobile device* of a subscriber is capable of handling a requested service. If yes, a location identifier of the

subscriber is obtained, and a registration attempt may be terminated (Step 611), depending on the subscriber location. Accordingly, the Office Action cited a mobile communication device to allege that Denenberg describes a network element.

Contrary to the Office Action's allegations, Denenberg fails to describe a network element, and more particularly, fails to describe either a network element serving the terminal device, or registering a terminal device to a new serving network element depending on the result of a check of the capability of the serving network element.

One of ordinary skill in the relevant art would have understood that Denenberg fails to describe a change in a serving network element because no serving network element is necessary before determining if the mobile device's capabilities are consistent with a requested service. Thus, there can be no registration to a new serving network element.

Furthermore, contrary to the Office Action's allegations, Denenberg, at column 4, lines 35-41, fails to describe a subscription change. Rather, Denenberg describes a first-time activation after a phone has been leased or bought and is activated for the first time. Denenberg fails to describe subscription information being changed. Accordingly, Denenberg fails to disclose or suggest each and every element recited in claim 1.

Although the clear errors are submitted with respect to the rejections presented for independent claim 1, the same clear errors exist with respect to each of the rejections of independent claims 32, 37, and 40. Accordingly, the Office Action's rejections of claims 1-20, 32-37, and 40-42 under 35 U.S.C. §102(e) based on Denenberg are in clear error for at least the reasons discussed above. Therefore, claims 1-20, 32-37, and 40-42 should be in condition for allowance. Accordingly, these rejections should be summarily withdrawn.

Clear Error: Hurtta is invalid prior art under 35 U.S.C. §103(c).

Applicants respectfully submit that Hurtta is invalid prior art under 35 U.S.C. §103(c). Under 35 U.S.C. §103(c), "subject-matter developed by another person, which qualifies as prior art only under one or more subsections of (e), (f), and (g) of Section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person."

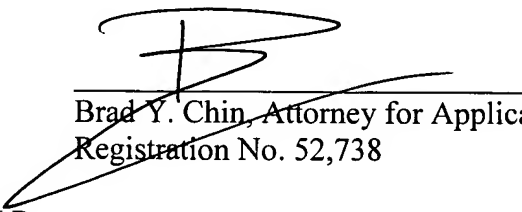
Applicants respectfully submit that Hurtta is prior art, if at all, only under 35 U.S.C. §102(e). Applicants further submit that both the present application and Hurtta are subject to an obligation of assignment to Nokia Corporation.

Evidence of the present application's assignment to Nokia Corporation may be found in the assignment recorded July 21, 2004, at reel 016021 and frame 0686. Evidence of Hurtta's assignment to Nokia Corporation may be found in the assignment recorded August 26, 2003, at reel 014527 and frame 0661. Accordingly, it is respectfully submitted that Hurtta and the present application were both subject to an obligation of assignment to the same entity at the time of the invention, namely to Nokia Corporation. Therefore, according to 35 U.S.C. § 103(c), Hurtta is not valid prior art in support of a rejection of the claims in the present application under 35 U.S.C. § 103(a).

Accordingly, Applicants respectfully submit that the use of Hurtta to reject claims 38-39 and 43 is in clear error for at least the reasons discussed above. As the rejections cannot stand without Hurtta, Applicants respectfully request that the rejections of claim 38-39 and 43 be summarily withdrawn.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Enclosures: Notice of Appeal, PTO/SB/33 Form, Petition for Extension of Time
Check No. 21021